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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/626,973 | 07/25/2003 | Ronald D. Blum | 63049.001003 | 3786 |

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| EXAMINER | |
|---|---|
| SCHWARTZ, JORDAN MARC | |
| **ART UNIT** | **PAPER NUMBER** |
| 2873 | |

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/626,973 | BLUM ET AL. |
| | Examiner | Art Unit |
| | Jordan M. Schwartz | 2873 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10/3/03,12/11/03, 3/5/04 (Pre-Amendmts)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-58* are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

***Restriction***

A previous restriction dated February 18, 2004 had been sent out by the examiner, however, that restriction apparently crossed in the mail with a preliminary amendment of applicant's received March 1, 2004 that had added new claims. Therefore, this present restriction is being sent out to replace the previous restriction and addresses all pending claims 1-58.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, 16-27, drawn to a spectacle lens or optical apparatus, classified in class 351, subclass 159.

II. Claims 13-15, drawn to a method for producing a spectacle lens, classified in class 351, subclass 177.

III. Claims 28-36 and 43-46, drawn to an optical measuring system, classified in class 351, subclass 205.

IV. Claims 37-42, 51-58. Claims 37-38 and 51-54 are drawn to a method for examining a patient's eye, classified in class 351, subclass 246. Claims 39-42 and 55-58 are being grouped together with claims 37-38 and 51-54 because they could be searched together with these claims without providing an undue burden on the examiner.

V. Claims 47-50, drawn to a method for correcting a patients vision, classified in class 351, subclass 246.

The inventions are distinct, each from the other because of the following reasons:

Inventions in Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, with respect to claims 1-12 of Group I and Group II, the product can be made by another and materially different process such as a process in which conventional refractive error correction is based on a lens prescription determined by a wave front analysis while non-conventional refractive error is determined by any means other than wave front analysis. With respect to claim 16 of Group I and Group II, the product can be made by another and materially different process such as a process that does not use wavefront analysis. With respect to claims 17-27 of Group I and Group II, the product can be made by another and materially different process such as a process that does not modify the peripheral edge of a lens to fit within an eyeglass frame.

Inventions in Group III and Group I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, with respect to claims 1-12 and 16 of Group I and Group III, the combination as

claimed does not require the particulars of the subcombination as claimed because the optical measuring system does not specifically require an eyeglass lens as a refractor. In the instant case, with respect to claims 17-27 of Group I and Group III the combination as claimed does not require the particulars of the subcombination as claimed because the optical measuring system does not require an optical power of the optic to be adjusted while the patient is looking through the optic. The subcombination has separate utility such as, with respect to claims 1-12 and 16, eyeglasses to provide refractive error correction to a wearer, and with respect to claims 17-27, an apparatus for determining refractive error having power adjusted while the patient looks through the optic.

Inventions in Group II and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as by any process in which the optical system produced does not require a process step of modifying the peripheral edge of a lens to fit within an eyeglass frame.

Inventions in Group I and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case the process for using the product can be practiced with another and materially different product such as with a lens that does not have the peripheral edge modified to fit within an eyeglass frame.

Inventions in Group III and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case with respect to claims 28-36 of Group III and Group IV, the process for using the product can be practiced with another and materially different product such as a measuring system that uses an auto-refractor i.e. a measuring system that does not use a wave-front analyzer. In the instant case with respect to claims 43-46 of Group III and Group IV, the process for using the product can be practiced with another and materially different product such as a measuring system that is not capable of subjectively and objectively measuring a patient's refractive error.

Inventions in Group I and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product can be practiced with another and materially different product such as with a product that does not

require a lens or modifying the peripheral edge of a lens to fit within an eyeglass lens or with a product that does not require adjusting an optical power while a patient looks through an optic.

Inventions in Group III and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product can be practiced with another and materially different product such as with a product that uses an autofocuser and does not use a wave-front analyzer or with a product that is not capable of subjectively and objectively measuring the patients refractive error.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I contains the following patentably distinct species: Group Ia, claims 1-12, directed to a species of spectacle lens or optical device wherein a portion of the refractive error correction is based on a lens prescription determined by a wave front analysis; Group Ib, claim 16, directed to a species of spectacle lens or optical device that uses adaptive optics to correct for non-conventional refractive error and provide better than 20/20 vision; Group Ic, claims 17-27 directed to a species of spectacle lens or optical device wherein an optical power of the optic is adjusted while the patient looks through the optic.

Group III contains the following patentably distinct species: Group IIIa, claims 28-36, directed to a species of optical measuring system that does not require a wave-front analyzer and which quantifies refractive error along the line of sight of the patient; and Group IIIb, claims 43-46 directed to a species of optical measuring system capable of subjectively and objectively measuring the patients refractive error.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

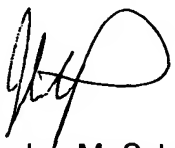
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number

is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
March 12, 2004